

REMARKS

It is noted that this official action that the Applicant is now responding to is the third non-final official action. To date, the originally filed claims have not been amended in any substantive fashion. Some of the originally filed claims have been amended to remove reference numerals or to remove multiple dependencies, but those amendments certainly do not narrow the claims. It is noted, for example, in the official action dated December 10, 2002 that the Examiner rejected the claims on a number of grounds and, moreover, cited certain art which was made of record but not relied upon, which included U.S. Patent No. 5,670,972 to Kim. A response was filed to that official action and, in response thereto, the Examiner withdrew the previous rejections and issued the latest official action in which the Examiner asserts, for the first time, that the claims are unpatentable over the previously cited patent of Kim.

The Applicant objects to this piecemeal prosecution of this patent application. The prior patent of Kim was clearly available to the Examiner in December 2002, yet the Examiner decided, for whatever reason, not to apply Kim against the claims. Then in July of this year, the Examiner applied Kim against the claims for the first time. Since the Examiner could have made these rejections in the December 10, 2002 official action, that clearly points to the fact that piecemeal prosecution is occurring, and the Applicant objects to this treatment by the USPTO since piecemeal prosecution violates 37 C.F.R. 1.104.

Moreover, 35 U.S.C. 1.104 also requires that when a prior art reference is complex or shows or describes inventions other than that claimed by the Applicant, the rules require that "the particular part relied upon must be designated as nearly as practicable." As will be explained below, the official action dated July 7, 2003 does not identify the particular parts that the Examiner relies upon in the Kim reference, or perhaps the real problem is that the Examiner is trying to read limitations set forth in the claims on subject matter which cannot be found in the

prior art references, which only leads the Applicant to question why the Examiner is citing Kim not only belatedly, but why is the Examiner bothering to cite the Kim reference at all?

Turning to claim 1, the Examiner asserts that Kim discloses a communication process between an Information Handling System (IHS) and at least one display having On Screen Display (OSD) capability. The Examiner points the Applicant to the abstract.

First, why is the Examiner pointing the Applicant to the abstract? Does that mean that the elements noted above are not shown elsewhere in Kim? It would seem that the Examiner, in compliance with the rules of practice, which require the Examiner to identify the particular part as nearly as practicable, could identify those portions of Kim which supposedly read upon the preamble of claim 1 by pointing to reference numerals in the drawings and line numbers in the detailed description of Kim. Moreover, just what part of the abstract of Kim supposedly meets the "Information Handling System" limitation of claim 1? The abstract mentions a lot of things, including "a cable connector," "amplifiers," and "a cathode ray tube." Upon which of those elements or other elements mentioned in the abstract does the Examiner read the "Information Handling System" limitation of claim 1? The Applicant should not have to speculate as to these issues, especially since the rules of practice put the onus on the Examiner to identify the particular part relied upon "as nearly as practicable" as required by 37 C.F.R. 1.104.

Second, continuing on with the Examiner's analysis of claim 1, the Examiner asserts that the element "graphic system" is taught by column 3, lines 22-27 of Kim. Those lines refer to a cable connector 1 (which is shown in Figure 1) and the fact that a particular type of video signal is applied thereto. So where is the graphic system? Is it something which is upstream of the connector 1 shown in Figure 1, and therefore is the Examiner attempting to read the graphic system limitation of claim on something which is not shown in Kim? If so, then the Examiner's rejection under 35 U.S.C. 102, which requires the prior art reference to teach each and every

limitation of the claim, is unquestionably improper. Or does the graphic system limitation of claim 1 allegedly read on something downstream of the connector shown in Figure 1? If so, then the Examiner's action does not comply with 37 C.F.R. 1.04, as previously stated. Or does the Examiner maintain that a simple connector alone meets this limitation?

Third, claim 1 also recites "an electronic circuit operating independently of said processor and said graphic system." Where is the recited circuit shown in Figure 1 or elsewhere in Kim? The Examiner points the Applicant to column 2, lines 44-59. However, at that point there is again a discussion, among other things, of the signals applied to the connector. This discussion occurs in that portion of the Kim patent relating to the summary of the Kim invention. Does that mean that there is no technical description of these elements later on in the patent application that the Examiner could have pointed to instead, thereby referencing the specific elements relied upon by reference numerals or some other clearer indication of just what is supposed to be related to the language of the claim? The bottom line is that the Examiner does not identify where in Kim there is any disclosure of "an electronic circuit operating independently of said processor and said graphic system" with any clarity, and thus the Applicant has no idea as to which element or elements in Kim supposedly meet that limitation.

Fourth, when it comes to identifying the processor, the Examiner has no problem pointing to element 7 depicted in Figure 1. Why does the Examiner have a problem in identifying "an electronic circuit operating independently of said processor and said graphic system" as recited in claim 1 in the same fashion? The only conclusion the Applicant can come to is that the element apparently is not disclosed by the Kim reference, and therefore the Examiner's rejection of claim 1 under 35 U.S.C. 102 is improper.

Fifth, claim 1 also recites a "service channel." Where is that shown in Kim? The Applicant should not have to speculate as to just how the Kim patent allegedly anticipates claim 1. The

Examiner has the obligation, when rejecting a claim under 35 U.S.C. 102, of showing where each and every limitation of claim 1 can be allegedly found in Kim. Since the Examiner has not made a *prima facie* case for rejection of claim 1 under 35 U.S.C. 102, the rejection is improper and the Examiner is respectfully requested to withdraw the rejection.

Claim 6 is also rejected by the Examiner as being fully anticipated by Kim.

Many of the limitations found in claim 6 have already been discussed above. For example, claim 6 recites, among other things, “a graphics system.” Where does Kim teach a graphics system? The Examiner points to connector 1 shown in Figure 1 of Kim. Does the Examiner honestly believe that connector 1 meets the graphic system limitation of claim 6? If not, then just what elements shown in Kim allegedly meet the “graphic system” limitation of claim 6? Also, where does Kim allegedly meet “an electronic circuit operable independently of said processor” limitation or the “service channel” limitation of claim 6?

The Applicant should not have to speculate as to why the Examiner is rejecting claim 6 in this application based upon Kim.

With respect to claim 15, similar questions as to those raised above with respect to claim 6 also apply. Where does Kim teach “a graphic system,” “an electronic system operating independently of said processor and said graphic system,” and “a service channel allowing interaction between said display and said operating system” as recited by claim 15. Again, the Applicant should not have to speculate as to why the Examiner is rejecting the claims in this application.

Turning briefly to the Examiner’s rejections of certain elements of the claims under 35 U.S.C. 103, the Applicant objects to the *ex post facto* analysis which the Examiner applies to

Applicant's claims in order to arrive at his prior art rejections. The Examiner cites Kim in view of VESA. The VESA document, at page 22 thereof, shows a display system. Note that the display already has a bi-directional communication capabilities on the display data channel (DDC).

The Examiner evidently wants to replace the display system shown in Figure 22 with that of Kim. But Kim does not have a "bi-directional serial communication link" according to the Examiner. So why would one of ordinary skill in the art want to substitute Kim for the display system already shown in the VESA document? Just to make things more difficult? The Examiner says that you do it to "maximize reliability." How does replacing the VESA document's display with another display "maximize reliability?" The VESA document shows an LCD display while Kim teaches a cathode ray tube. How does replacing an LCD display with a CRT device contribute in any way to maximizing reliability? On what basis does the Examiner make that assertion? Is there any factual basis for the assertion? If so, please state it for the record and supply an affidavit as required by the rules of practice.

It is to be noted that the motivation for combining the two prior art references is supposed to come from the prior art itself. Where is there motivation in these two documents to remove the display system shown on page 22 of the VESA document and replace it with the Kim display? Why do that in view of the fact that the Kim display would not work since it does not have a bi-directional bus? Why replace something which obviously works with something which will not work? Why replace an LCD display with a CRT display? With all due respect to the Examiner, the only reason the Examiner is making this assertion is because he has used Applicant's claims as a road map to the prior art, as opposed to looking at what the prior art would teach to a person of ordinary skill in the art who did not have the privilege of reading Applicant's patent application.

The same *ex post facto* (road map) approach can be seen in the other rejections made by the Examiner. For example, consider paragraph 18 where the Examiner talks about the graphic system. In the Examiner's analysis of Kim, the graphic system is allegedly connector 1 shown in Figure 1. Now the graphic system becomes an AGP or PCI graphics card. Overlooking the problem with Kim in that a connector can hardly be characterized as being a graphic system, why would someone of ordinary skill in the art replace a connector with a graphics card? To be sure, graphics cards have two or more connectors associated with them, in that they plug into a slot in the computer and typically have connectors for connecting to a monitor, but why replace Kim's connector with a graphics card? It is submitted that a person of ordinary skill in the art would be apt to connect Kim's connector 1 to a graphics card, but certainly not replace it with a graphics card. However, according to the Examiner's analysis of claim 4, that is the position that the Examiner takes. Also, claim 4 recites, among other things, "at least two conductors being reserved for said I²C communication link..." The Examiner acknowledges that fact at the last two lines on page 6 of his analysis, but when the Examiner turns to the prior art, the claim language "being reserved for" is all of a sudden overlooked. How is that limitation allegedly being met by the prior art? The Examiner points to column 4, lines 14-17 of Nelson. How does the Examiner read the "reserved for" terminology of claim 4 on the quoted passage in Nelson?

With all due respect to the Examiner, if the Examiner is going to reject the claims in this application, the Examiner must deal with each and every limitation of each claim and show where each and every limitation of each claim can be found in the prior art. If the Examiner is going to combine references, then the Examiner needs to show where there is a suggestion in the prior art to make the combination being asserted by the Examiner. As things presently stand, the Examiner overlooks limitations found in the claims which are not conveniently found in the prior art and also suggests combinations of prior art reference using a road map approach based on Applicant's claims, as opposed to seriously considering whether or not a person of ordinary skill in the art would have combined the teachings of the prior art in the manner suggested.

Since this is a non-final rejection, the Applicant has the privilege of adding new claims, which has been done. It is submitted that the new claims also distinguish themselves from the prior art.

Reconsideration is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on

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(Date of Deposit)

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